

III. REMARKS/ARGUMENTS

A. Remarks.

Claims 1-23 are pending in the application, claim 24 is being added with this paper. The drawings are objected to and corrected drawings have been requested. Claim 10 is objected to for having insufficient antecedent basis. Claims 1-9, 11-13, 15, 16, 18, 19 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Garrett U.S. Patent No. 4,019,580. Claims 1-5, 8-10, 21, 13, 15-18, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tedder U.S. Patent No. 4,772,849. Claims 14 and 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tedder '849 in view of Hulsing et al. U.S. Patent No. 4,343,654.

B. Response

1. Drawings

The drawings were objected as noted in the Notice of Draftperson's Patent Drawing Review and for having two elements having the reference number "53". Attached herewith are Replacement Sheets provided in response to the notice. Also attached is new Figure 2A, this figure provides more detail with regard to a portion of the device of Figure 2. No new matter is contained within Figure 2A.

With regard to element "53", this reference number concerns O-rings, although the same reference number is being used to identify different elements, because these elements are substantially the same, multiple use of this reference number is believed to be proper. Reconsideration of the objection is requested.

2. Claim 10

Claim 10 was objected for referring lacking antecedent basis for “said orifice”, claim 10 has been amended to depend from claim 9. Claim 9 recites an orifice, accordingly as amended, the orifice of claim 10 now has sufficient antecedent basis.

3. 35 U.S.C. § 102(b) – Garrett ‘580

Claims 1-9, 11-13, 15, 16, 18, 19 and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Garrett ‘580. Garrett ‘580 was cited for disclosing a rotating tool with a body, a compression assembly, a hydraulic assembly, and a lead screw. Garrett ‘580 was further said to disclose a compression assembly comprising a selectively compressible compression element, wherein the hydraulic assembly comprises a reservoir with an open and closed end and wherein its piston is threadingly coupled with the lead screw and slidingly coupled with the body so that piston movement produces body rotation.

In response, a rejection under 35 U.S.C. § 102(b) requires that the cited reference contain each and every element of the rejected claim. Claim 1 has been amended to clarify that selective expansion of the compression element correspondingly produces movement of the piston. In contrast, the piston of Garrett ‘580 is moved by applying pressurized fluid from the surface through a drill string to the downhole tool (column 8, line 46 – column 9, line 4, and column 10, line 66 – column 11, line 22). Garrett ‘580 does not disclose a tool with a compression element whose expansion produces piston movement.

With regard to pending claim 16, it clearly recites how decompression of the compression element in turn produces piston movement. Because Garrett ‘580 fails to include a tool with a

compression element that expands to produce piston movement, this reference does not teach each and every element of claim 1 or claim 16 and should be removed as a basis for the rejection of these claims. Since claims 2-15, 18, 19, and 22 all depend directly or indirectly from these claims, Garrett '580 should be removed as a basis for the rejection of these claims as well.

4. 35 U.S.C. § 103(a) – Tedder '849

Claims 1-5, 8-10, 21, 13, 15-18, 22 and 23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tedder '849. Tedder '849 was cited for the proposition that it discloses a tool having a body, a compression assembly and a hydraulic assembly, where the compression assembly comprises a selectively compressible compression element and the hydraulic assembly comprises reservoir with an open end and a closed end. The reservoir of Tedder '849 was said to be fillable with fluid and formed to receive a piston within the open end, where the piston is slidingly coupled with the body such that movement of the piston towards the closed end causes body rotation. Although Tedder '849 does not disclose a lead screw, it was alleged that the connection described therein was equivalent to a lead screw connection. It was thus concluded that it would have been obvious to substitute the connection means of Tedder '849 to a lead screw connection means.

In response, to sustain a rejection under 35 U.S.C. § 103(a) a *prima facie* case of obviousness must be established, M.P.E.P. § 2142. To establish a *prima facie* case of obviousness three basic criteria must be met. First, there must be some suggestion or motivation either in the references themselves or in the knowledge generally available to one of ordinary

skill in the art to modify the reference or to combine reference teachings. *Id.* Second, there must be a reasonable expectation of success. *Id.* Finally, the prior art references (or references when combined) must teach or suggest all the claim limitations. *Id.*

As previously noted, pending claims 1 and 16 recite a selectively expandable compression element whose expansion in turn produces movement of the piston. This is unlike the device of Tedder '849 that relies on pressurized water to compress a spring and move the piston (column 4 lines 5 – 10). Moreover, there is no suggestion within Tedder '849 that selective expansion of its spring could in turn produce piston movement. It is therefore respectfully requested that Tedder '849 be removed as a basis for the rejection of claims 1 and 16 and their respective dependent claims.

It should also be pointed out that the device of Tedder '849 is insufficiently analogous to applicant's device in order to be cited as a reference for the rejection of the present claims. "In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). Tedder '849 concerns tubing inspection by electromagnetic imaging. This field of technology is distinct from the field of exploration and production of hydrocarbons from wellbores.

5. 35 U.S.C. § 103(a) – Tedder '849 and Hulsing et al. '654

Claims 14 and 20-21 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Tedder '849 in view of Hulsing et al. U.S. Patent No. 4,343,654. For the reasons stated above,

Tedder '849 is an inappropriate reference for the rejection of the pending claims and Hulsing et al. '654 is only appropriate due to its reference to a gyroscope. Thus since combining these two references does not teach or suggest the device of claims 14 or 20 -21, it is respectfully requested that Tedder '849 and Hulsing et al. '654 be removed as a basis for the rejection of claims 14, 20, and 21.

6. New claim 24

New claim 24 depends from claim 1 and should therefore be in condition for allowance. This claim recites the additional limitation of wherein selective fluid flow through the orifice enables fluid to evacuate said reservoir thereby enabling movement of the piston. Support for this amendment can be found in page 16, lines 10-20 of the application as originally filed. Accordingly this new claim adds no new matter.

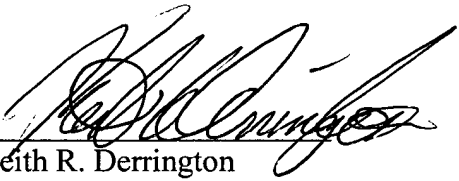
III. CONCLUSION

Replacement sheets are in filed in compliance with 35 C.F.R. § 1.121(d) and new Figure 2A adds no new matter. Claim 10 as amended now has proper antecedent basis. Furthermore, it is urged that applicants' claims are patentable in light of the prior art and that the rejections of claims 1-23 under 35 U.S.C. § 102(b) and 35 U.S.C. § 103(a) should be removed. New claim 24 adds no new matter. It is believed that the foregoing response is full and complete. Applicant respectfully requests reconsideration of the instant application in light of the foregoing response and amendments.

Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of the application, the Examiner is invited to contact the Applicants' representative by telephone or fax.

Respectfully submitted,

Date: November 8, 2005



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